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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/843,072	04/26/2001	Rodney Carlton Burnett	AUS920010162US1	8490

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01/04/2007

EXAMINER

LEMMA, SAMSON B

ART UNIT

PAPER NUMBER

2132

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/04/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/843,072

Applicant(s)

BURNETT ET AL.

Examiner

Samson B. Lemma

Art Unit

2132

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-13 and 22-28 is/are allowed.
- 6) ☒ Claim(s) 14-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. This office action is in reply to an amendment filed on September 29, 2006.
Claims **1-28 are pending.**
2. In pervious office action, **claims 1,22 and 23** were rejected under 35 U.S.C. 112, second paragraph, as being indefinite. However, the claims are amended and the amendment successfully overcomes the rejection. Thus the rejection is withdrawn.
3. In pervious office action examiner **indicated that the application would be allowed** if the applicant successfully overcomes the 35 U.S.C. 112, second paragraph rejection. However further consideration revealed that the limitation recited **in claims 14-21** are directed to non-statutory subject matter.
4. The first office action was made on January 12, 2005. Examiner for rejecting the claims used a prior art namely "Tivoli Secure Way Director For Operating Systems reference" which had a copyright date of November 7, 2000. The Effective filing date of the application is April 26, 2001.
However, Applicants traversed the examiner's first office action and argued that Tivoli is a division of IBM, which is the same assignee of the present application. Applicant further argued that the cited reference merely documents the inventors own invention. Further, applicant indicated that the reference only displays a copyright notice of 2000 and this fact does not indicate the exact date of the publication. In addition, applicant said that the present invention was submitted for internal review and preparation of the patent application prior to these release dates.
Examiner on August 17,2005, requested (Requirement under Rule 105) the applicant so that the applicant would submit the publication date of the

reference. Applicant confirmed that the record of the Assignee show a date of conception of July 18, 2000. Applicant further indicated that the internal approval process for IBM and the process of preparation and filing of the application immediately followed.

For the above reason, the "Tivoli" reference used as a prior art which had copyright date of November 7, 2000 is withdrawn as the applicant indicated that the conception date of the application is on July 18, 2000 which is before the reference date. (November 7, 2000).

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. **Claims 14-21** are rejected under 35 U.S.C. 101 because the subject matter is directed to non-statutory subject matter.

7. **Claims 14-21** are directed **to instructions/program**. Though the preamble of the independent claim 14, recites computer program product is in a computer readable medium, the examiner asserts that the limitation of the claim raises a question as to whether or not the instructions/program performs the function recited on the body of the claim when the instructions/program is read and executed by the computer/processor. The claim does not clearly establish a statutory category of the invention.

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Furthermore, The language of the claims raises a question as to whether the last limitation recited in the claim as, "instructions for generating an authorization, decision for the access attempt based on the security policies that govern all entries in the database protecting the system resource," is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, **and tangible result** to form the basis of statutory subject matter under 35 U.S.C. 101. See MPEP § 2106 IV. B. 1(a). Therefore the claim is a program per se and does not fall within the statutory classes listed in 35 USC 101.

Allowable Subject Matter

8. **Claims 1-13 and 22-28** are allowed.
9. **Claims 14-21** would be allowed if the applicant overcome the 35 USC § 101 rejection set forth in this office action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samson B Lemma whose telephone number is 571-272-3806. The examiner can normally be reached on Monday-Friday (8:00 am---4: 30 pm). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, BARRON JR GILBERTO can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you

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have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SAMSON LEMMA

S.L.
12/15/2006


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SUPERVISORY PATENT EXAMINER
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